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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

ABDUL REHMAN KARIM SALEH,

Plaintiff,

v.

SULKA TRADING LTD.,

Defendant.

CIVIL ACTION

No.

DECLARATORY JUDGMENT COMPLAINT

Nature Of The Case

1. Plaintiff Abdul Rehman Karim Saleh (“Saleh” or “Plaintiff”) seeks to use the trademark SULKA in connection with clothing items in U.S. Commerce. Defendant Sulka Trading Ltd. owns several U.S. trademark registrations for same. However, Defendant has for several years abandoned all use of that mark in commerce in the United States and has lost all trademark rights therein. Nevertheless, Defendant falsely insists that it continues to use that mark and has trademark rights, and that any use by Plaintiff would infringe its rights. Saleh accordingly seeks a declaratory judgment that Defendant has abandoned its rights in that mark, and for an order cancelling Defendant’s trademark registration.

Jurisdiction

2. The Court has jurisdiction over this matter pursuant to 28 U.S.C. § 2201 in that there is an actual and real controversy among the parties as to whether Defendant has extant trademark rights in the mark SULKA or has abandoned same,

and whether Plaintiff may proceed to use such mark in connection with clothing items and other goods in U.S. Commerce; pursuant to 28 U.S.C. §§ 1331 and 1338 to the extent the controversy concerns such trademark rights under federal law, including the Trademark Act of 1946, 15 U.S.C. § 1051, *et seq.*, and pursuant to 28 U.S.C. §§ 1367 and 1338(b) to the extent the controversy concerns trademark rights under state and common law.

Plaintiff and Its Business Plans To Use the SULKA Mark

3. Plaintiff Saleh is an individual with an address at 7B Shiva Tower Sukhumvit Soi 15, Bangkok 10110, Thailand.

4. Saleh has made concrete plans to market various clothing and leather goods items in the United States and other countries under the trademark SULKA.

5. Saleh has applied to register that mark in connection with “luggage, wallets, purses, computer laptop cases, handheld PC cases” and “shirts, dresses, neckties, belts, pants, scarves” in the United States Patent and Trademark Office, Serial No. 88/021619. The application is pending.

Defendant and Its Abandoned Trademark

6. Defendant Sulka Trading Ltd. is a corporation organized under the laws of the British Virgin Islands, having an address at Citco B.V.I. Limited, Wickhams Cay P.O. Box 662 Road Town, Tortola, British Virgin Islands.

7. Defendant is the successor to prior businesses or entities that used the mark SULKA in the U.S. and foreign commerce, in connection with various goods.

Defendant is currently the owner of the following U.S. Trademark registrations: Nos. 4,998,527, 4,998,512, 2,077,773, 826,139, and 310,430, for various clothing items and related goods and services (collectively the “SULKA Registrations”). (This list does not include cancelled or abandoned registrations.)

8. Despite its maintenance of these registrations, defendant Sulka has in fact not used the mark in U.S. commerce for any of the goods listed in its registrations, or indeed any goods, for more than three years, and upon information and belief, for significantly longer than three years. During this period of time, defendant Sulka discontinued use of the SULKA mark with intent not to resume such use, and made no bona fide use of such mark in the ordinary course of trade. Any “use” of the mark during this period was made merely to reserve a right in the SULKA mark. Accordingly, defendant Sulka has abandoned and lost all rights in the SULKA mark.

The Controversy

9. On August 28, 2018, Plaintiff’s counsel wrote to Defendant’s house counsel outlining its plans to enter the U.S. market and setting forth its position that Defendant had abandoned its trademark rights in the SULKA mark. Defendant Sulka replied through its U.S. outside counsel on August 31, 2018, and the parties exchanged further correspondence on September 6 and September 14, 2018. Defendant Sulka through its counsel has continued to maintain that it did not abandon its trademark rights and that any use by Plaintiff of the SULKA mark as per his plans would infringe its rights and demanded that Plaintiff cease his plans and abandon his pending trademark application.

10. Plaintiff, on the other hand, maintains that defendant Sulka has abandoned its trademark rights in the mark SULKA, and accordingly he may proceed with his plans to market clothing and leather goods items in the United States under the mark SULKA and that any use by Plaintiff of the mark SULKA would not infringe any rights of defendant Sulka under 15 U.S.C. §§ 1114(1) and 1125(a), the common law or any state law.

11. There is accordingly a real case and controversy between the parties as to their respective rights in the SULKA mark.

WHEREFORE Plaintiff Saleh requests the following relief:

(1) A declaration that defendant Sulka Trading Ltd. has abandoned and lost all trademark rights in the United States in connection with the mark SULKA; that plaintiff Saleh is free to use that mark in connection with the goods listed in his pending trademark application in U.S. commerce and that any use by plaintiff Saleh of the mark SULKA would not infringe any rights of defendant Sulka under 15 U.S.C. §§ 1114(1) and 1125(a), the common law or any state law.

(2) Cancellation of the Sulka Registrations (Nos. 4,998,527, 4,998,512, 2,077,773, 826,139, and 310,430) pursuant to 15 U.S.C. § 1119.

(3) Attorney's fees and costs of the action.

(4) Such other relief as the Court deems just and equitable.

Dated: October 11, 2018

SPRINGUT LAW PC

By: /s/ Milton Springut

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